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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,270	12/30/2003	Saikumar Jayaraman	884.888US1	7480
21186 7590 02/12/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
TSOY, ELENA				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
02/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/751,270

**Applicant(s)**

JAYARAMAN, SAIKUMAR

**Examiner**

Elena Tsoy

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 14-24 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-20 and 31-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

Amendment filed on December 12, 2007 has been entered. Claims 1-12, 14-24, and 31-36 are pending in the application. Claims 21-24 are withdrawn from consideration as directed to a non-elected invention.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 5, 7, 10-12, 14, 15, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al in view of Suda et al (US 4731855) and Kamieniecki et al (US 5661408) for the reasons of record set forth in paragraph 4 of the Office Action mailed on 10/09/2007 because the amendment does not change the scope of claimed invention.

3. Claims 1, 2, 4-12, 14-20, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter (US 6,730,617) in view of Suda et al and Kamieniecki et al for the reasons of record set forth in paragraph 5 of the Office Action mailed on 10/09/2007 because the amendment does not change the scope of claimed invention.

4. Claims 3, 6, 20, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al in view of Suda et al and Kamieniecki et al, as applied above, and further in view of Bulthaupt et al (US 6,936,181) for the reasons of record set forth in paragraph 10 of the Office Action mailed on 7/27/2006.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al in view of Suda et al and Kamieniecki et al/Carter in view of Suda et al and Kamieniecki et al/, as applied above, and further in view of Walter et al (US 4,099,913) for the reasons of record set forth in paragraph 9 of the Office Action mailed on 7/27/2006.

6. Claims 6, 8, 9, 16, 20, 31-32, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al in view of Suda et al and Kamieniecki et al, as applied above,

and further in view of Carter for the reasons of record set forth in paragraph 12 of the Office Action mailed on 7/27/2006.

***Response to Arguments***

7. Applicant's arguments filed December 12, 2007 have been fully considered but they are not persuasive.

**§103 Rejection of the Claims**

**Jacobson et al. in view of Suda et al. and Kamieniecki et al.**

The Office admits therein Jacobson fails to teach in-situ testing the substrate while attached as part of an array of substrates. Suda and Kamieniecki do not remedy Jacobson because Jacobson's technology if applied to either of Suda or Kamieniecki, would destroy such inventions. Further, the "substrate" of Jacobson is not the "substrate" of either of Suda or Kamieniecki. Consequently, merely that of either of Suda or Kamieniecki may teach testing of their substrates, fails to show a teaching or suggestion to combine their technologies with Jacobson. Further, Jacobson would not look to either of Suda or Kamieniecki to solve any technical challenges or fields of endeavor.

The Examiner respectfully disagrees with this argument. First of all, Suda and Kamieniecki were cited by the Examiner **only** to show that ***in-line or in-situ testing was known in the art of manufacturing semiconductor devices for e.g. fast testing of patterns on semiconductor wafers, etc. to reduce the financial losses resulting from errors.*** The Examiner never addressed the testing techniques because they were not recited in claims. Therefore, in contrast to Applicants assertion, neither Jacobson's technology was applied to either Suda or Kamieniecki nor testing techniques of Suda or Kamieniecki were applied to Jacobson.

**Carter in view of Suda et al. and Kamieniecki et al.**

The Office admits that "Carter fails to teach in situ testing the substrate while attached as part of an array of substrates." Suda and Kamieniecki have nothing to do with what is claimed. Similarly to the above rejection involving Jacobson, the disconnect lies between Carter and the Suda and Kamieniecki references, where Carter's technology if applied to either of Suda or Kamieniecki, would destroy such inventions. Further, the "substrate" of Carter is not the "substrate" of either of Suda or Kamieniecki. Consequently, merely that of either of Suda or Kamieniecki may teach testing of their substrates, fails to show a teaching or suggestion to combine their technologies with Jacobson. Further, Carter would not look to either of Suda or Kamieniecki to solve any technical challenges or fields of endeavor.

The Examiner respectfully disagrees with this argument for the reasons discussed above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1792

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.  
Primary Examiner  
Art Unit 1762

February 12, 2008

/Elena Tsoy /

Primary Examiner, Art Unit 1792